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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/725,394	11/29/2000	Wesley W. Whitmyer JR.	03000- P0004C WWW/CJP	9725
24126	7590	06/22/2005	EXAMINER	
ST. ONGE STEWARD JOHNSTON & REENS, LLC 986 BEDFORD STREET STAMFORD, CT 06905-5619			NGUYEN, CINDY	
			ART UNIT	PAPER NUMBER
			2161	

DATE MAILED: 06/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/725,394	<b>Applicant(s)</b> WHITMYER, WESLEY W.	
	<b>Examiner</b> Cindy Nguyen	<b>Art Unit</b> 2171	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03/14/05.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 February 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

This is in response to communication filed 03/14/05.

#### **1. Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-6, 8-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Schneider (US 5987464).

Regarding claim 1, Schneider discloses: a system for automating the recordation of a property transfer comprising: an Internet server (302, fig. 8 and corresponding text, Schneider); a communications link between said Internet server and the Internet (144, fig. 8 and corresponding text, Schneider); at least one database (350, fig. 11 and corresponding text, Schneider) containing a plurality of information records accessible by said Internet server, each information record including an intellectual property identification number (350, fig. 11 and corresponding text, Schneider); at least one database (140, fig. 12 and corresponding text, Schneider) containing a plurality of recordation forms accessible by said Internet server (col. 16, lines 34-64, Schneider); software executing on said Internet server for receiving a transfer request indicative of a transfer of rights to the property (34, fig. 12, Schneider);

software executing on said Internet server for querying said database of information records to retrieve an information record corresponding to a transfer request for querying said database of recordation forms to retrieve a recordation form corresponding to said transfer request (col. 16, lines 14-63, Schneider).

Regarding claims 3 and 8, all the limitations of these claims have been noted in the rejection of claim 1. It is therefore rejected as set forth above. In addition, Schneider discloses: a at least one database containing a plurality of information records accessible by said Internet server, each information record including an intellectual property identification number and a jurisdiction identifier (350, fig. 11 contains patent numbers and 140, fig. 12 contains expired patent, col. 18, lines 40-67, Schneider);

software executing on said Internet server for receiving a transfer request indicative of a transfer of rights to the property (92, fig. 4, Schneider).

In addition, Schneider disclose: software executing on said Internet server for querying said database of information records to retrieve an information record corresponding to a transfer request for querying said database of recordation forms to retrieve a recordation form corresponding to said transfer request (fig. 3-5, col. 5, lines 43 to col. 6, lines 54, Schneider), and for combining the retrieved information record with the retrieved recordation form to generate a document (col. 16, lines 14-63, Schneider).

Schneider discloses: software executing on said Internet server for transmitting said property transfer request form through the Internet (34, fig. 12, Schneider);

software executing on said Internet server for receiving a reply to said property transfer request form (col. 10, lines 26-38, Schneider);

software executing on said Internet server for transmitting said transfer document through the Internet (92, fig. 4, Schneider);

software executing on said Internet server for updating said database containing a plurality of information records (34, fig. 5 and col. 7, lines 38-47, Schneider).

Regarding claims 2, 4 and 9, most of the limitations of these claims have been noted in the rejection of claims 1, 3 and 8 above, respectively. In addition, Schneider discloses: wherein said property is intellectual property such as patents, copyrights, and trademarks (col. 16, lines 14-63, Schneider).

Regarding claims 5 and 6, all the limitations of these claims have been noted in the rejection of claim 3. In addition, Schneider discloses: comprising of software executing on said Internet server for receiving and transmitting an executed transfer document (col. 16, lines 34-64, Schneider).

Regarding claim 10, all the limitations of this claim have been noted in the rejection of claim 8. In addition, Schneider discloses: comprising of software executing on said internet server for retrieving said updated to said database containing a plurality of information records through the internet from a plurality of sources (34, fig. 5 and col. 7, lines 38-47, Schneider).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2161

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schneider (US 5987464) in view of Rabne et al. (US 6006332).

Regarding claim 7, all the limitations of this claim have been noted in the rejection of claim 3. However, Schneider didn't disclose: comprising of software executing on said internet server for transmitting said executed transfer document to a property recordation authority. On the other hand, Rabne discloses: comprising of software executing on said internet server for transmitting said executed transfer document to a property recordation authority (col. 22, lines 37-67, Rabne). Thus, at the time invention was made, it would have been obvious to a person of ordinary skill in the art to include a software executing on said internet server for transmitting said executed transfer document to a property recordation authority in the system of Schneider as taught by Rabne. The motivation being to enable the system provide a secure environment for intellectual property management, when an access permission is received can the system can obtains the intellectual property stored in a secure fashion.

### **3. Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Roberts et al. (U.S 6292788). Methods and investment instruments for performing tax-deferred real estate exchanges.


Stefik et al. (U.S 5634012). System for controlling the distribution and use of digital works having a fee reporting mechanism.

### **4. Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cindy Nguyen whose telephone number is 571-272-4025. The examiner can normally be reached on M-F: 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 571-272-4023. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7240 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

  
Cindy Nguyen  
May 24, 2005

  
**FRANTZ COBY**  
**PRIMARY EXAMINER**